

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

**Karamchedu et al.**

Application No.: 10/635,184

Filed: August 6, 2003

For: Method and Apparatus for Semantic  
Qualification and Contextualization  
of Electronic Messages

Examiner: David Eng

Art Unit: 2155

Confirmation No.: 9182

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

CONSIDERED: /D.E./

04/07/2009

**REPLY TO EXAMINER'S ANSWER**

Dear Sir:

Appellants hereby acknowledge receipt of the Examiner's Answer, mailed October 15, 2008, and offer the following remarks in reply.

The Examiner's Answer argues on page 4 that the Specification fails to identify the computing device recited in claim 1. However, Figure 1 clearly shows a sending device 104, with a messaging client 106 and semantic qualification logic 108. Sending device 104 is communicatively coupled to local server 102 and so forth. Such devices are clearly computing devices. The text associated with Figure 1, and other text in the Specification, supports the recitation of "computing device" in claim 1. See also, for example, Figures 9 and 10 and the associated text in the Specification.

The Examiner's Answer further argues that the Specification does not identify how to identify a context of a message. As a result, the Examiner improperly ignores the first clause of the body of claim 1, namely "determining by a computing device a context to be applied to an electronic mail message," and instead inserts the Examiner's own desired

meaning. As such, the Examiner asserts that the first portion of claim 1 “merely recites generating an electronic message or email.” Appellants respectfully disagree.

The Examiner’s statements regarding contextualization are more akin to a 35 U.S.C. §112 rejection, although no such rejection is pending. In this regard, Appellants submit that the features of the claims meet the requirements of 35 U.S.C. §112. Support for determining a context to be applied to a message may be found throughout the Specification, for example at page 16, line 21 to page 17, line 14.

Regardless of the statements above, the ground at issue is whether claims 1 and 3-48 are unpatentable under 35 U.S.C. §103(a) over Morris and Meyerzon. Thus, the question is whether the cited references teach or suggest the features of the claims.

As discussed in the Appeal Brief, Morris and Meyerzon, individually or in combination, fail to teach or suggest all the features of claim 1, and, in particular, fail to teach or suggest at least (1) determining a context to be applied to an electronic mail message, and (2) identifying one or more elements within the electronic mail message based at least in part upon the context.

At page 7 of the Answer, the Examiner argues that Appellants read limitations from the Specification into the claims. Rather, Appellants point to the teachings of the Specification to assist the Examiner in understanding the claims. Claim terms are to be read in light of the Specification, and Appellants merely provide an illustrative mapping of the claim terms to assist in the reading of the claims and to identify locations in the Specification for support of the claims.

The Examiner further argues that Appellants do not indicate why the features of claim 1 are patentably distinct over the cited references, and do not argue why the rejection is in error. The response is straightforward – the cited references do not teach or suggest at least (1) determining a context to be applied to an electronic mail message, and (2) identifying one or more elements within the electronic mail message based at

least in part upon the context. The features of claim 1 thus provide an embodiment that is novel and nonobvious over the cited references. Therefore, the rejection of the claims over Morris and Meyerzon is in error.

### **Conclusion**

As discussed in detail in Appellants Appeal Brief, the Examiner misinterpreted the teachings of the references and has thus provided inadequate rejections of the claims.

Therefore, as Appellants have set forth in the Appeal Brief, the Examiner has erred in the Examiner's rejections. Appellants respectfully request the Board to reverse the Examiner's rejections.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
Schwabe, Williamson & Wyatt, P.C.

Date: December 1, 2008

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